

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

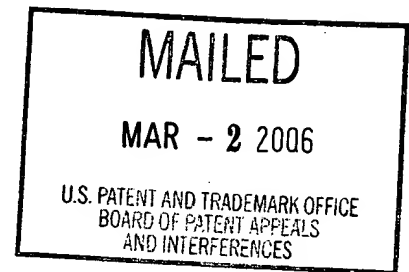
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL SCHWARTZ and JARON JURIKSON-RHODES

Appeal No. 2006-0315  
Application No. 09/706,508

HEARD: February 7, 2006



Before GROSS, BLANKENSHIP, and NAPPI, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 38-49, which are all the claims remaining in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

### BACKGROUND

The invention relates to a portable communication device configured to fit substantially in and around the listener's ear. Claim 38 is reproduced below.

38. A communication device comprising:

a speaker configured to direct sounds towards an ear canal of a listener's ear and a component configured to fit substantially in a concha portion of the listener's ear; and

a housing connected to the component, the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker.

The examiner relies on the following references:

Hahn et al. (Hahn)	US 6,230,029 B1	May 8, 2001 (filed Jan. 7, 1998)
Avnet et al. (Avnet)	US 2002/0094787 A1	Jul. 18, 2002 (filed Apr. 5, 2001) <sup>1</sup>
Edmonds	GB 2 214 740 A	Sep. 6, 1989

Claims 38 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hahn.

Claims 38, 39, and 42-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edmonds and Hahn.

---

<sup>1</sup> According to the front page of the published application, the application is a non-provisional of provisional applications filed April 7, 2000 and April 12, 2000.

Appeal No. 2006-0315  
Application No. 09/706,508

Claims 41 and 45-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edmonds, Hahn, and Avnet.

We refer to the Final Rejection (mailed Jul. 30, 2004) and the Examiner's Answer (mailed Feb. 24, 2005) for a statement of the examiner's position and to the Brief (filed Nov. 8, 2004) and the Reply Brief (filed Mar. 23, 2005) for appellants' position with respect to the claims which stand rejected.

### OPINION

#### Rejections over prior art

We reverse, pro forma, the rejection of claims 38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Hahn, the rejection of claims 38, 39, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over Edmonds and Hahn, and the rejection of claims 41 and 45-49 under 35 U.S.C. § 103(a) as being unpatentable over Edmonds, Hahn, and Avnet. Rejections of claims over prior art should not be based on speculation and assumptions as to the scope of the claims. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We conclude that at least claim 38 (the sole independent claim) is indefinite under 35 U.S.C. § 112, second paragraph. We set forth, accordingly, a new ground of rejection infra.

We will briefly discuss, however, our views with respect to the Hahn reference. The controversy in the prior art rejections appears to center on what Hahn is deemed to disclose.

We agree with the examiner that Hahn discloses a communication device that includes a speaker module 14' (Fig. 3) that is configured to fit substantially in a concha portion of a listener's ear. The "concha," as appellants indicate in the Brief (at 7), refers to the hollow of the external ear. We consider the examiner's taking of "Official Notice," that a speaker module having a size that can be fitted in a concha portion of a listener's ear is common in the art, to be unnecessary. As the examiner notes at page 8 of the Answer, Hahn does not express in the text of the patent that the speaker module is configured to fit substantially in a concha portion of the listener's ear. However, as the examiner also indicates, Hahn at column 5, lines 42 through 56 teaches that the ear hook 12 may be deformable (e.g., flexible ear hook 12 in Fig. 1A) or the speaker module 14' "may be movable in two or three dimensions to allow for greater customization in the fitting of the wireless headset module to the user's ear." Figure 3 depicts pivoting of speaker module 14' in two dimensions (i.e., along arrow 52). Movement in a third dimension would be in a direction away from, or toward, the user's ear canal and concha such that the speaker module may, and is configured to, fit substantially in a concha portion of the listener's ear.

We also agree with the examiner that Hahn teaches a housing that is configured to be substantially supported by a pinna of the listener's ear. The "pinna" is the projecting part of the ear lying outside of the head. Dorland's Illustrated Medical Dictionary, Twenty-sixth Ed. at 1020 (1981).

Appellants take a contrary position, founded in part on Hahn's disclosure at column 5, lines 16 through 23 that the user would deform the ear hook portion 12 (Fig. 1A) towards the speaker module 14 in order to "clamp" the pinna of the user's ear between the ear hook 12 and the speaker module 14 and thereby fasten the wireless headset 10 to the user's ear. The reference states, with respect to the Figure 3 embodiment, that speaker module 14 can be movable in two or three dimensions to thereby shorten or lengthen the distance between the exterior of the speaker module 14' and the edge of the ear hook 12' in order to "clamp" the pinna of the user's ear between the speaker module 14' and the ear hook 12'. Col. 5, ll. 42-51.

That Hahn teaches clamping the pinna of the user's ear between the ear hook and the speaker module would seem to indicate beyond a doubt that Hahn teaches that the device housing is substantially supported by a pinna of the listener's ear. Appellants seem to hold (e.g, Brief at 5-6) that Hahn's use of the word "clamp" means that the uppermost portion of the pinna is to be deformed and threaded to opposing sides of ear hook 12 (Hahn Fig. 1D), such that the ear hook sits atop the uppermost cartilaginous portion of the pinna (whatever discomfort that may cause the user). We disagree with appellants' assessment of the reference. Moreover, even if the ear hook were "clamped" to the pinna as appellants indicate, the device housing would still be substantially supported by a pinna of the user's ear. We disagree with appellants' seeming view (e.g., Reply Brief at 2) that a device that is "clamped" to a structure cannot be "supported" by the structure.

New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claims 38-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Instant claim 38 recites, "a speaker configured to direct sounds towards an ear canal of a listener's ear and a component configured to fit substantially in a concha portion of the listener's ear. . . ." Appellants in the Brief (at 3-4) indicate that disclosed speaker 18 (Figs. 4A, 4B, and 4C) corresponds to the claimed "speaker," and that disclosed "component" 18 (Figs. 4A, 4B) corresponds to the claimed "component." The drawings and the written description, however, describe speaker 18 that "is configured to fit substantially in the concha portion 28 of the ear 26." (Spec. at 4, ll. 14-15.) When questioned at the oral hearing where the claimed "component" is described, appellants' counsel replied that in the preferred embodiment of the invention the "speaker" and the "component" are the same.

Appellants' Brief and remarks at the oral hearing indicate that appellants have failed to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. For a claim to comply with § 112, second paragraph, it must satisfy two requirements: first, it must set forth what “the applicant regards as his invention,” and second, it must do so with sufficient particularity and distinctness, i.e., the claim must be sufficiently “definite.” Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377, 55 USPQ2d 1279, 1282 (Fed. Cir. 2000). During the prosecution of a patent application before the USPTO, a claim’s compliance with both portions of § 112, second paragraph, may be analyzed by consideration of evidence beyond the patent specification, including an inventor’s statements to the agency. Id.

Appellants’ position, that the “speaker” and the “component” may be the same structure, is contrary to the clear language of instant claim 38. The claim requires both a “speaker” and a “component.”

We note that consideration of claim 38 also raises issues with respect to the written description requirement of 35 U.S.C. § 112, first paragraph, to the extent that the recitation of the “speaker” and the additional “component” may be considered as setting forth definite structures. To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the “written description” inquiry, whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the

claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). We do not find disclosure in the specification or drawings of a speaker configured to direct sounds toward an ear canal of a listener's ear and a component configured to fit substantially in a concha portion of the listener's ear. However, the greater problem appears to reside in a basic disagreement as to what the claims require. We therefore focus on the problem of claim ambiguity, and do not now enter a rejection for lack of written description.

Claim 38 has a further problem in the recitation of the "housing" containing substantially all other components of the communication device "other than the speaker." The only named "component" in the claim is that configured to fit substantially in a concha portion of the listener's ear. As the only named "component," it would appear that it must be within "substantially all other" components other than the speaker, and thus contained in the housing. However, the configuration of the "component" with respect to the ear would seem to be irrelevant when the component is contained in a housing.

The dependent claims incorporate the limitations of base claim 38, and are therefore rejected for the same reasons as claim 38. Further, if we were to assume that claim 38 passes muster under 35 U.S.C. § 112, second paragraph, dependent claim 39 would still be indefinite. The claim recites, "[t]he communication device of claim 38 wherein the device is used in promotion of a preexisting publicly available broadcast." A claim that recites both an apparatus and a method of using that apparatus is



indefinite under 35 U.S.C. § 112, second paragraph. See IPXL Holdings LLC v. Amazon.com Inc., 430 F.3d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005) (a claim that recites both a system and the method for using that system does not apprise a person of ordinary skill in the art of its scope, and is thus invalid under § 112, second paragraph).

### CONCLUSION.

The rejection of claims 38-49 under 35 U.S.C. § 103(a) is reversed, pro forma.

A new rejection of claims 38-49 under 35 U.S.C. § 112, second paragraph is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (2005). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Appeal No. 2006-0315  
Application No. 09/706,508

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

REVERSED -- 37 CFR § 41.50(b)



ANITA PELLMAN GROSS  
Administrative Patent Judge



HOWARD B. BLANKENSHIP  
Administrative Patent Judge



ROBERT E. NAPPI  
Administrative Patent Judge

)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)  
)

Appeal No. 2006-0315  
Application No. 09/706,508

VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103